

## II. General Remarks Concerning This Response

Claims 1-6 and 8-20 are currently pending. In this response, independent claims 1, 9, 10, 11, 15, and 20 are amended; no claims are added; and claim 7 is canceled.

5 Prior art references from other co-pending patent applications that are related to the present patent application are being submitted in an IDS that is being mailed separately from this response, which is being faxed.

10 The Office action contains a request to submit a substitute specification because the original specification contains numerous typographical errors; a substitute specification is being mailed separately from this response.

15 The Office action objected to the specification for containing a copyright notice that does not conform with the requirements of the MPEP; a new copyright notice will be submitted in the substitute specification.

20 Other Office actions for related co-pending patent applications contain an objection to the specification in accordance with MPEP § 608.01 because the specification contains embedded "browser-executable code", such as HyperText Markup Language (HTML) or eXtensible Markup Language (XML) tags. Applicant has not modified the specification to remove these HTML tags because the present invention is directed to a process or a system for manipulating such markup language tags. As stated in MPEP § 608.01(a), if the forms of browser-executable code are part of an applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. § 112, ¶ 1, examiners should not object to such tags.

The pending Office action for the present patent application contains an objection against claim 7 for being in improper dependent form; claim 7 has been canceled.

5     **III. Rejections under 35 U.S.C. § 103(a)—Obviousness**

          The Office action has rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over *Document Object Model (DOM) Level 1 Specification, Version 1.0*, World Wide Web Consortium (W3C), 10/01/1998, in view of Gounares et al.,  
10     "HTML/XML Tree Synchronization", U.S. Patent Application Publication US 2003/0028561 A1, published 02/06/2003, filed 05/19/1999. These rejections are traversed.

          Each of the independent claims, as amended, contains a new element that reads substantially:

15           passing given information to a method in a tag handler, wherein the tag handler is registered in a tag library, wherein the tag library contains one or more elements defining tags, wherein an element defining the tag  
20           contains an attribute for the tag handler that processes an instance of the tag.

          In the present invention, a custom tag defines a semantic of given content on a page, which may be uniquely specified by a web page author. Web page authors can use this mechanism to  
25     add custom tags to the page markup; custom tags serve as markers that initiate the invocation of tag handlers that, in turn, perform reorganization or manipulation of the document. A set of related custom tags can be collected and packaged into a custom tag library. Each custom tag has an identifier  
30     and a set of one or more attributes, including a tag handler attribute. The tag handler attribute specifies a tag handler that can be either a class, e.g., a Java class, or a

stylesheet. The tag handler is the entity that performs the manipulation of the document in which an instance of the custom tag appears as document markup.

5 The amended feature is not disclosed by the applied prior art nor the prior art of record. The specification explicitly discusses the fact that the JSP 1.0 specification teaches custom tags and a tag extension mechanism, i.e., a tag library mechanism. However, the JSP 1.0 specification does not teach the amended feature of the pending claims of the present  
10 application. The specification of the present application clearly distinguishes the present invention from the JSP 1.0 specification. The specification of the present application states on page 19, last paragraph:

15 [T]he JSP 1.0 specification included a tag library mechanism that defines how to plug in a tag. The specification, however, left the details of the taglib mechanism completely open, with the exception that a URL must be used to specify the location of the taglib.

20 This statement is supported in the final draft of the JSP 1.0 specification, which has been cited by Applicant in the IDS that is being mailed as part of Applicant's current response to the pending Office action. The final draft of the JSP 1.0 specification states in Chapter 1, p. 17, last paragraph:

25 The JSP 1.0 specification has mandatory and optional features. JSP 1.0 enables a tag extension mechanism for the creation of custom tags but such a mechanism will not appear until a later version of the specification.

30 The subsequent section of the specification of the present application then describes a specific mechanism for implementing a custom tag library, and the amended feature of the claims is directed to this specific mechanism. Hence,

Applicant reiterates that the JSP 1.0 specification does not teach the features of the pending claims of the present application. Although the JSP 1.1 specification describes a specific mechanism for implementing a custom tag library, it should be noted that each of the pending independent claims states that the tag handler is specified as an attribute in a definition of a custom tag, which is not shown in the JSP 1.1 specification nor other prior art references.

Applicant asserts that the above-noted deficiencies in the rejections are sufficient to require the withdrawal of the rejections based on the applied prior art. The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of

nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

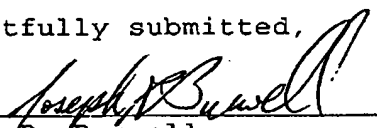
With respect to the pending claims, the rejections argue that a combination of the applied prior art references  
5 discloses the claimed features, but Applicant has shown above that the applied prior art references fail to disclose the features of the claims as amended. Hence, the rejections do not establish a *prima facie* case of obviousness with respect to the claims. Therefore, the rejections of all pending claims  
10 under 35 U.S.C. § 103(a) in view of the applied prior art have been shown to be improper, and the claims are patentable over the applied references. Applicant requests the withdrawal of the rejections.

15 V. Conclusion

For any outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

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Respectfully submitted,

  
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